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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,464	11/20/2003	Hidchiko Fujiwara	Q78503	6839

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EXAMINER	
WONG, XAVIER S	

ART UNIT	PAPER NUMBER
2609	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/716,464	FUJIWARA ET AL.	
	Examiner	Art Unit	
	Xavier Wong	2609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *20th Nov 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 - 10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 - 10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *20th Nov 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *20-Nov-2003 & 23-Apr-2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

The information disclosure statements submitted on *20th November 2003* and *23rd April 2007* have been considered by the Examiner and made of record in the application file.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims **1 – 4, 9** and **10**, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Waseda et al (JP 2001-54151 A)** in view of **Nilsson et al (WO 00/70845 A1)**.

Consider claims **1** and **2, Waseda et al** disclose a connector *20* (adaptor) that connects a mobile phone *30*, through a PBX *10* and the internet (IP) *100/200* as phone *1*, dialing through mobile phone *30* (therefore, input from mobile phone), to a phone *2* (paragraphs *0011-13* & *0016*; figs. *1*, *6*, *10* and *11*) wherein: when a call is received to the private phone's number, the connection status of the mobile phone (connected to connector or not) is determined (paragraphs *0053-54*).

While **Waseda et al** did not specifically mention a *VoIP* extension section; nonetheless, the inventors mention an ISDN interface *39* (attached to the connector *20* through the mobile phone *30*) that establishes connection with PBX *10* in order to allow communication with the (private) phone and the mobile phone (paragraphs *0045-46*; figs. *2* & *9*) as the VoIP extension section. It would have been obvious to a person of

ordinary skill in the art at the time of the invention was made to incorporate the teachings of the VoIP extension unit for the purpose of allowing analog (private phone) and digital (mobile phone) voice data communication.

Nonetheless, **Waseda et al** did not explicitly mention a telephone control unit for managing the mobile phone's resource data; and when a call is made by inputting on the mobile phone, then the number is converted into the private phone's number and the call is made to the phone number of the called private phone unit.

In the same field of endeavor, **Nilsson et al** disclose a phone number conversion unit *20* to be adapted into a mobile device so that when user inputs a phone number to the mobile device, depending on the calling destination (internal, site within PBX, external, etc.), to convert the according number. Device also comprises a control unit for execution and handling telephone book (resources –directory data) in the conversion unit (pg. *2* lines *13-23*, pg. *3* lines *7-16* & pg. *4* lines *11-27*; claims *4* & *9*; figs. *1* & *2*).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the teachings of a telephone control unit for managing the mobile phone's resource data; and a conversion of the mobile phone unit input number into the private phone's number and the call is made to the phone number of the called private phone unit as taught by **Nilsson et al**, in the adaptor of **Waseda et al**, in order to allow calls to be made to internal and external networks using a common telephone book, independent of access network.

Consider claims **3** and **4**, and as applied to claim **2** above, **Waseda et al**, as modified by **Nilsson et al**, disclose when a (private) phone *T11* receives a call, and if the mobile phone connector/adaptor *30* is not connected to the mobile phone, then the call is transferred/forwarded to a designated terminal (phone number) according to a database *D9* inside PBX *10*; else if there is not a designated number, then the call is transferred/forwarded to the mobile phone *30* (paragraphs *0064-65*; claim *18*; fig. *16*).

Consider claims **9** and **10**, and as applied to claims **1** and **2**, though **Waseda et al**, as modified by **Nilsson et al**, did not explicitly mention a battery charger for the mobile phone – **Waseda et al** disclose a "current source" (power supply *25*) inside the adaptor *20* that can draw power from the PBX (paragraph *0049*; fig. *6*) – it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the teachings of an adaptor comprising a battery charger for a mobile phone to act as an alternative power source for the mobile phone.

Claims **5** and **6**, are rejected under 35 U.S.C. 103(a) as being unpatentable over **Waseda et al (JP 2001-54151 A)** in view of **Nilsson et al (WO 00/70845 A1)**, and as applied to claims **1** and **2** above, and in further view of **Roach (EP 1,032,224 A2)**.

Consider claims **5** and **6**, and as applied to claims **1** and **2**, **Waseda et al**, and as modified by **Nilsson et al**, disclose the claimed invention except explicitly mentioning the linkage between a mobile phone telephone directory and an IP-PBX telephone directory.

In a related field of endeavor, **Roach** describes a memory unit in a mobile phone that stores a menu (directory) of phone numbers that to connect with the PBX (col. *7* lines *24-56* & col. *10* lines *10-31*), in which the PBX directory is mentioned above.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the teachings of linking an (IP)-PBX directory and a mobile phone directory, as taught by **Roach**, in the adaptor of **Waseda et al**, as modified by **Nilsson et al**, for the purpose of identity authentication of pre-existing users.

Claims **7** and **8** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Waseda et al (JP 2001-54151 A)** in view of **Nilsson et al (WO 00/70845 A1)** and in further view of **Keenan et al (U.S 6,577,631 B1)**.

Consider claims **7** and **8**, and as applied to claims **1** and **2**, **Waseda et al**, as modified by **Nilsson et al**, disclose the claimed invention except the adaptor comprising a QoS controller for minimizing audio data loss due to congestion over an IP network.

In the same field of endeavor, **Keenan et al** disclose a User Terminal Equipment (UTE) adapter, which is compatible to be inserted into a digital (mobile) phone, comprising controlling mechanism for Quality of Service (QoS) characteristics such as audio and video delay sensitive information when congestion occurs in an Internet/Ethernet (IP) access environment (col. *1* lines *36-53*, col. *5* lines *60-66*, col. *7* lines *4-25*, col. *8* lines *46-66*, col. *10* lines *9-23* & col. *23* lines *50-57*; figs. *3* & *4*).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of the invention was made to incorporate the teachings of an adaptor comprising a QoS controller, as taught by **Keenan et al**, in the adaptor of **Waseda et al**, as modified by **Nilsson et al**, in order to minimize audio/video data loss and long delays due to congestion over an IP/Ethernet network.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A.) **Shaffer et al (U.S Patent 6,549,534 B1)** mention a private network user may originate a call to someone outside in the public mobile/wireless telephone network through the use of a protocol adapter installed on the mobile phone unit.

B.) **Ranalli et al (U.S Pub 2003/0076933 A1)** mention a directory service database (through the internet) that helps determine the delivery paths between IP-PBX enabled systems and a destination phone number.

Any response to this Office Action should be **faxed to** (571) 273-8300 **or mailed to**:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Hand-delivered responses should be **brought to**:

Customer Service Window
Randolph Building

401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xavier Wong whose telephone number is (571) 270-1780. The examiner can normally be reached on Monday through Friday 8 am - 5 pm (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rafael Perez-Gutierrez can be reached on (571) 272-7915. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call (800) 786-9199 (IN USA OR CANADA) or (571) 272-1000.

Xavier Szewai Wong
X.S.W/x.s.w
30th April 2007

RAFAEL PEREZ-GUTIERREZ
SUPERVISORY PATENT EXAMINER
5/2/07